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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,433	11/30/2004	Rory Joseph Donnelly	GRW-0001	3004
29344	7590	09/08/2006	EXAMINER	
MILLS & ONELLO LLP ELEVEN BEACON STREET SUITE 605 BOSTON, MA 02108			BUI, BING Q	
			ART UNIT	PAPER NUMBER
			2614	

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/516,433	<b>Applicant(s)</b> DONNELLY ET AL.	
	<b>Examiner</b> Bing Q. Bui	<b>Art Unit</b> 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/30/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-9 are pending in the application for examination, wherein claims 1 and 6 being independent.

#### ***Claim Objections***

2. Claims 1, 3 and 8 are objected to because of the following informalities:

(a) As to claim 1, character semi-colon [ ; ] at the end of the recited claim should be deleted and replaced with period character -- . --

(b) As to claim 3. it definitely depends on claim 1, not on claim 2, because "the control device" is cited in claim 1, not in claim 2. Therefore, [ or 2 ] in line 2 should be deleted.

(c) As to claim 8. it definitely depends on claim 6, not on claim 7, because "the security device" is cited in claim 6, not in claim 7. Therefore, [ or 7 ] in line 1 should be deleted.

3. Claims 4-5 and 9 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim 4 has not been further treated on the merits.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Newell (US Pat No. 4,953,202).

Regarding claim 1, referring to Figures 1-3, Newell teaches a telecommunication security device in the form of a separate unit stored in a lockable housing (46), the device comprising:

(i) a first connector for connection to a telecommunications device (see Abstract; figs 1-3; col. 2, ln 44-col. 3, ln 25; and col. 4, ln 62-col. 7, ln 8);

(ii) a second connector for connection to a telecommunications line (see Abstract; figs 1-3; col. 2, ln 44-col. 3, ln 25; and col. 4, ln 62-col. 7, ln 8);

(iii) a switch having a normally closed position in which a signal pathway within the security device between the first connector and the second connector is enabled and an open position in which the signal pathway is interrupted (see Abstract; figs 1-3; col. 2, ln 44-col. 3, ln 25; and col. 4, ln 62-col. 7, ln 8);

(iv) a control for controlling the position of the switch (see Abstract; figs 1-3; col. 2, ln 44-col. 3, ln 25; and col. 4, ln 62-col. 7, ln 8);

(v) a programmable memory for storing allowed signal sequences and at least one authorized pass number (see Abstract; figs 1-3; col. 2, ln 44-col. 3, ln 25; and col. 4, ln 62-col. 7, ln 8);

(vi) a comparator in operative connection with the control device for comparing signals on the pathway with the allowed stored signal sequences, the control device being adapted to open the switch when a signal on the pathway does not match one of the stored signal sequences (see Abstract; figs 1-3; col. 2, ln 44-col. 3, ln 25; and col. 4, ln 62-col. 7, ln 8);

(vii) a programmer adapted to receive pass numbers and programming signals from a remote telecommunications device via a telecommunications line connected to the second connector, the programmer including an authorized pass number recognition device for comparing a received pass number with the authorized pass numbers stored in the memory, and being adapted to program the memory only when an authorized pass number is received (see Abstract; figs 1-3; col. 2, ln 44-col. 3, ln 25; and col. 4, ln 62-col. 7, ln 8) and

(viii) a battery (42) for powering the security device, wherein the control device is adapted to open the switch when no operative telecommunications device is connected to the first connector, thereby to save battery power (see Abstract; figs 1-3; col. 2, ln 44-col. 3, ln 25; and col. 4, ln 62-col. 7, ln 8).

Regarding claim 2, referring to Figures 1-3, Newell teaches the telecommunications security device according to claim 1, wherein the lock (48) of the

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housing (46) is key operated (see Abstract; figs 1-3; col. 2, In 44-col. 3, In 25; and col. 4, In 62-col. 7, In 8).

Regarding claim 3, referring to Figures 1-3, Newell teaches the telecommunications security device according to claim 1. wherein the control device (24, 25) is adapted to open the switch (20, 21) when the lockable housing (46) is unlocked (see Abstract; figs 1-3; col. 2, In 44-col. 3, In 25; and col. 4, In 62-col. 7, In 8).

Regarding claim 4, referring to Figures 1-3, Newell teaches the telecommunications security device according to claim 1, wherein the telecommunications device (15) is the modem of a computer, wherein the control device (25) is adapted to open the switch (2\*) when the modem is connected to an Internet service provider and signal sequences on the pathway (23) do not match one of the stored signal sequences (see Abstract; figs 1-3; col. 2, In 44-col. 3, In 25; and col. 4, In 62-col. 7, In 8).

Regarding claim 5, referring to Figures 1-3, Newell teaches the telecommunications security device according to any preceding claim, further comprising a third connector (49) for connecting the security device to a telephone handset (50), the third connector (49) being connected within the security device to the programmer (32), whereby the memory (26) can be further programmed by use of the handset (50) (see Abstract; figs 1-3; col. 2, In 44-col. 3, In 25; and col. 4, In 62-col. 7, In 8).

As to claims 6-9, they are rejected for the same reasons set forth to rejecting claims 1-5 above.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art in general:

U.S. Pat. No. 5,448,630

U.S. Pat. No. 7,082,191

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bing Bui, Tel. No. (571) 272-7482. The examiner can normally be reached on Monday through Thursday from 7:30 to 5:00.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300 and for formal communications intended for entry (please label the response ☐EXPEDITED PROCEDURE☐) or for informal or draft communications not intended for entry (please label the response "PROPOSED" or "DRAFT").

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

Sep 03, 2006



**BING Q. BUI  
PRIMARY EXAMINER**